

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : 7,488,734                      Issued: February 10, 2009  
Appln. No. : 10/601,438                      Filed: June 23, 2003  
Applicant : Fensome et al                      Conf. No.: 7149  
TC/A.U. : 1617  
Examiner : Hui, San-ming  
Customer No. : 38199  
Title : METHODS OF TREATING HORMONE-RELATED CONDITIONS  
                    USING THIO-OXINDOLE DERIVATIVES

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR DEFERRAL OF RECONSIDERATION OF PATENT TERM ADJUSTMENT  
UNDER 37 CFR §1.705(d)

Dear Sir:

Patentees respectfully request that consideration of, and a decision regarding, their Application for Patent Term Adjustment be held in abeyance, pending a final, non-appealable, decision on the merits in Wyeth v. Dudas, 07-CV-1492 (D.D.C.), on appeal, 2009-1120 (Fed. Cir.) ("Wyeth v. Dudas").

1. Patentees filed an Application for Patent Term Adjustment including Request for Reconsideration under 37 CFR §1.705(d) on April 3, 2009.

2. Wyeth (an Assignee of this patent) and Elan Pharma International Limited filed a civil action in the United States District Court in and for the District of Colombia against Jon W. Dudas, as Under Secretary of Commerce for Intellectual Property and Director of the USPTO

(07-CV-1492 (D.D.C.). This case is on appeal to the United States Court of Appeals for the Federal Circuit (*Wyeth v. Dudas*, 2009-1120).

3. *Wyeth v. Dudas* relates to the interpretation of 35 USC §154, and in particular, the interrelation of 35 USC §§154(b)(1)(A) and (b)(1)(B).

4. Patentees' Application for Patent Term Adjustment is based on an interpretation of 35 USC §154, which is the subject of *Wyeth v. Dudas*. See Statement of Facts Accompanying Request for Reconsideration of Patent Term Adjustment, filed April 3, 2009, at paragraph 3.(B) and (C).

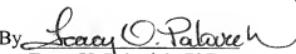
5. A proper determination regarding Patentees' Application including Request cannot be made, given that a final non-appealable decision on the merits in *Wyeth v. Dudas* will have collateral estoppel effect on the USPTO.

In view of the above, Patentees respectfully request that consideration of, and a decision regarding, their Application for Patent Term Adjustment including Request for Reconsideration under 37 CFR §1.705(d) be deferred until a final non-appealable decision on the merits in *Wyeth v. Dudas*.

Respectfully submitted,

HOWSON & HOWSON LLP

Dated: 8/21/09

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